

## REMARKS

This Amendment and Response is intended to fully respond to the Office Action dated November 20, 2003. In that Office Action, claims 1-6 and 8-28 were examined and all were rejected.

Reconsideration of the rejections, in view of these remarks, is respectfully requested.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 1-6 and 8-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,995,756 to Herrmann in view of U.S. Patent No. 6,594,682 to Peterson et al.

Initially, it is noted that the Peterson et al. application was recently issued (July 15, 2003) as U.S.P.N. 6,594,682. Furthermore, it is noted that the Peterson patent is assigned to Microsoft Corp., and that Microsoft is the assignee of the present application. Therefore, Peterson et al. cannot be cited in an obviousness rejection pursuant to 35 U.S.C. § 103(c).

Additionally, it is noted that the combination of Herrmann and Peterson et al. (even if such combination were proper) does not establish a prima facie case of obviousness. Indeed, such a prima facie case can only be met when **all** of the following requirements are met: (1) there must be some suggestion or motivation in the references themselves (or in the knowledge available to those skilled in the art) to combine the references; (2) there must be a reasonable expectation of success; and (3) the combined references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. In this case, there is no suggestion within the references themselves to combine the patents, nor would such a combination teach all of the claim limitations. Specifically, the combination does not teach determining an application functionality required to execute a file on a local computer when the computer is disconnected from a network and (if necessary) transferring such application functionality to the local computer prior to disconnecting the local computer from the network.

For the above reasons, Applicant respectfully requests that the § 103(a) rejections be withdrawn and that the pending claims 1-6 and 8-28 be allowed.

**Conclusion**

It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should the Examiner have any remaining questions or concerns, he is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

Dated: \_\_\_\_\_

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